

has questioned whether the evidence shows the claimed invention existed or was reduced to practice prior to 01/21/00 (the effective date of the Baer patent). Furthermore, the Examiner has asked for evidence of diligence to cover the period just prior to 03/01/00 of Morgenthaler up to the filing date of the present application (09/13/00).

Applicants provide herewith a true copy of IBM invention disclosure SMS8-1999-0016, of which dates have not been removed. This is the document of Exhibit A of the 1.131 Declaration. Attention is drawn to page 2, question 1 at the bottom. Inventors disclose that the invention was workable on 11/23/99, about 2 months before the effective date of the Baer patent.

Knowing the invention was workable, applicants then diligently submitted the invention disclosure to their employer, International Business Machines Corporation, on 11/26/99 (see page 1 under submitted date). As with most employers, the disclosure is eventually routed to an evaluation team (in this case called an IDT team) to determine whether a patent should be procured for the invention disclosed. This review process includes both technical and business factors, extensive discussion between the inventors and the IDT Team, and typically takes three to nine months to complete. In this case, this evaluation was completed on 5/23/2000 (see page 5 for date evaluated).

The disclosure is then assigned to an attorney/agent to draft the application. Typically, three to six months are needed to confer with the inventors and complete the patent application. In this case, the application was filed 9/13/00.

The evidence provided therefore demonstrates possession of a workable invention prior to the effective date of the earliest cited document. Furthermore, the inventors showed diligence thereafter by submitting the disclosure to their employer, conferring with the evaluation team, conferring with the attorney/agent, and filing the application. Applicants therefore request removal of the Baer and Morgenthaler documents from further consideration under 37. C.F.R. 1.131.

Applicants respectfully request withdrawal of the rejection of claims 1 - 12 under 35 U.S.C. 103(a) because the cited documents no longer apply in this application.

The Application is deemed in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707, 707.07(d) and 707.07(j) in order that allowable claims can be presented, thereby placing the application in condition for allowance without further proceedings being necessary.

Respectfully submitted,

Dated: 09/10/04

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Attachment - Disclosure SMS8-1999-0016



Disclosure SMS8-1999-0016

Prepared for and/or by an IBM Attorney - IBM Confidential

Created By Mark Goebel On 11/23/99 04:12:26 PM
 Last Modified By wpts1 wpts1 On 06/13/2002 04:29:05 PM EDT
 Archived on 09/01/2001

Required fields are marked with the asterisk (*) and must be filled in to complete the form .

*Title of disclosure (in English)

Worldwide Project Management Method (WWPMM)
 Worldwide Project Management Method (WWPMM)

Summary

Status	Final Decision (File)
Final deadline	
Final deadline reason	
Merged disclosures	END8-2000-0092
Docket family	END9-2000-0075
Original location	SMS
* Processing location	Endicott
* Functional area	(70) GS-(HEALD) IBM Global Services
Attorney/Patent professional	John Pivnichny/Endicott/IBM
IDT team	Richard Malek/Endicott/IBM Rob Edwards/Endicott/IBM Robert L King/Endicott/IBM Jon B. Martens/Endicott/IBM
Submitted date	11/26/1999 01:34:30 PM EST
* Owning division	GS
* Line of business	Primary Inventor's Line of Business (LoB)
* Industry/Sector	
* Competency	
Incentive program	
Lab	HEALD
* Technology code	

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IDT Selection

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IDT team	Richard Malek/Endicott/IBM Rob Edwards/Endicott/IBM Robert L King/Endicott/IBM Jon B. Martens/Endicott/IBM
Response due to IP&L	02/28/2000

Main Idea

To view the Main Idea of this disclosure, open the "Main Idea" document from the view

*Critical Questions (Questions 1-9 must be answered in English)

*Question 1

On what date was the invention workable? 11/23/1999 Please format the date as MM/DD/YYYY
 (Workable means i.e. when you know that your design will solve the problem)

***Question 2**

Is there any planned or actual publication or disclosure of your invention to anyone outside IBM?

Yes
 No

If yes, Enter the name of each publication or patent and the date published below.

Publication/Patent:

Date Published or Issued:

Are you aware of any publications, products or patents that relate to this invention?

Yes
 No

If yes, Enter the name of each publication or patent and the date published below.

Publication/Patent:

Date Published or Issued:

***Question 3**

Has the subject matter of the invention or a product incorporating the invention been sold, used internally in manufacturing, announced for sale, or included in a proposal?

Yes
 No

Is a sale, use in manufacturing, product announcement, or proposal planned?

Yes
 No

If Yes, identify the product if known and indicate the date or planned date of sale, announcements, or proposal and to whom the sale, announcement or proposal has been or will be made.

Product:
Version/Release:

Code Name:
Date:

To Whom:

If more than one, use cut and paste and append as necessary in the field provided.

***Question 4**

Was the subject matter of your invention or a product incorporating your invention used in public, e.g., outside IBM or in the presence of non-IBMers?

Yes
 No

If yes, give a date. Please format the date as MM/DD/YYYY

***Question 5**

Have you ever discussed your invention with others not employed at IBM?

Yes
 No

If yes, identify individuals and date discussed. Fill in the text area with the following information, the names of the individuals, the employer, date discussed, under CDA, and CDA #.

***Question 6**

Was the invention, in any way, started or developed under a government contract or project?

Yes
 No
 Not sure

If Yes, enter the contract number

***Question 7**

Was the invention made in the course of any alliance, joint development or other contract activities?

Yes
 No
 Not Sure

If Yes, enter the following:

Name of Alliance, Contractor or Joint Developer

Contract ID number

Relationship contact name

Relationship contact E-mail

Relationship contact phone

***Question 8**

Have you, or any of the other inventors, submitted this same invention disclosure or similar invention disclosure previously?

Yes

No

If Yes, please provide disclosure number below:

***Question 9**

Are you, or any of the other inventors, aware of any related inventions disclosures submitted by anyone in IBM previously?

Yes

No

If Yes, please provide the docket or disclosure number or any other identifying information below:

Question 10

What type of companies do you expect to compete with inventions of this type? *Check all that apply.*

- Manufacturers of enterprise servers
- Manufacturers of entry servers
- Manufacturers of workstations
- Manufacturers of PC's
- Non-computer manufacturers
- Developers of operating systems
- Developers of networking software
- Developers of application software
- Integrated solution providers
- Service providers
- Other (Please specify below)

Project management / consulting companies

Question 11

If the invention relates to a product or service that is outside the scope of your business unit, please recommend IBM business unit(s), IBM location(s) or individual(s) within IBM that you think would provide a good evaluation of your invention:

***Patent Value Tool (Optional - this may be used by the inventor and attorney to assist with the evaluation)**

(The Patent Value tool can be used by the inventor(s) to determine the potential licensing value of your invention.)

Market

*Question 1: What is the anticipated annual market size (in dollars) that will be captured by your invention?

Reason(s) for above Answer:

Claims

*Question 1: How new is the technical field?

Reason(s) for above Answer:

*Question 2: How central is the invention to the product(s) which might be expected to contain the

invention?

Reason(s) for above Answer:

*Question 3: What is the scope of the claim?

Reason(s) for above Answer:

Portfolio Need

*Question 1: What are the portfolio needs in the area of your invention?

Reason(s) for above Answer:

Exploitation & Enforcement

*Question 1: How easily can the use of the invention by a competitor be detected?

Reason(s) for above Answer:

*Question 2: How easily can the use of the invention be avoided by a competitor?

Reason(s) for above Answer:

Business Value

*Question 1: What percentage of the companies producing products in the field of this invention might use this invention?

Reason(s) for above Answer:

*Question 2: What is the value of this patent to current or anticipated Alliance Activity between IBM and other companies?

Reason(s) for above Answer:

*Question 3: What is the value of this patent to current or anticipated Technology Transfer Activity between IBM and other companies?

Reason(s) for above Answer:

*Question 4: Does it result in prestige to IBM?

Reason(s) for above Answer:

Evaluation

This team evaluation was entered by Georgia Brundage/Endicott/IBM on 05/24/2000

What is the team's evaluation of this disclosure? Search

Date evaluated : 05/23/2000

Evaluation comments

Final Evaluation History Search	Who made the final evaluation Georgia Brundage/Endicott/IBM	Final evaluation date 5/23/2000
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Search Information

Date sent: _____ *Target completion date: _____ Search results received date: _____

Who was the search sent to (This area is to designate a Local Searcher name or WAIPL):

*Search type: Patentability Clearance Validity State of Art

*Features to be searched:

Search Office Information

Target completion date: Search has been delayed Ship/Return date:

Search conducted by

Comments

Final Decision

This decision was entered by Georgia Brundage/Endicott/IBM on 06/01/2000

Decision: File Status: N/A

PPM area:

Date of final decision : 05/31/2000

Additional filing information

Planned Filing date:

Filing comments:

Additional decision comments

Final Decision History

Entered on 1-Jun-2000 by Georgia Brundage
File N/A 31-May-2000 Docket Family: END920000075

Entered on 1-Aug-2000 by Georgia Brundage
END8-2000-0092 has been merged into this disclosure

Post Disclosure Text & Drawings

To add additional information related to this disclosure once it has been submitted, click the action button below and a new document will be opened for you to enter the new information. To view existing post disclosure information, double-click on the item in the list below (if there has been additional information entered), and the document will open for you to view.

Date entered Post disclosure comments and drawings (double-click an item below to view)

Form Revised 09/01/02